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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,139	01/16/2004	Eric B. Cummings	33532/US	7218
7590 Edward W. Bulchis DORSEY & WHITNEY LLP 1420 Fifth Avenue Suite 3400 Seattle, WA 98101		10/29/2007	EXAMINER VATHYAM, SUREKHA	
			ART UNIT 1795	PAPER NUMBER
			MAIL DATE 10/29/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/760,139	Applicant(s) CUMMINGS ET AL.	
	Examiner Surekha Vathyam	Art Unit 1795	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 October 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): The 103 rejection of claim 21.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 12-21.
Claim(s) withdrawn from consideration: 1-11.

AFFIDAVIT OR OTHER EVIDENCE


8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). IDS filed on 6/29/07
13. ☐ Other: _____.

Continuation of 3. NOTE: New independent claim 22 which the applicant considers a clean new claim with the limitations of dependent claim 21 in independent form, raises several new issues such as broadening the scope of the claim by no longer requiring the limitation, "while avoiding suppression of electroosmotic flow of the sample fluid"; requiring that more than at least one particle i.e., a plurality of particles have their location be determined at least in part based on electric and geometrical properties of the particles; appearing to require the particles trapped in the ring be the same as the particle trapped at a location in the non-uniform array; requiring the location of the ring to be the same as the location of the particle, etc.

Continuation of 10. NOTE: Applicant's arguments in the remarks section along with exhibits 1 - 6 have been considered. The rejection of claim 21 under 35 USC 103 has been withdrawn. Applicant's arguments regarding the rejection of claims 12, 13 and 21 under 35 USC 103 as being unpatentable over Austin ('664) in view of Christel ('871) in light of exhibits 1 and 2 which define the words "radial" and "ray" respectively, are not found to be persuasive. The array of Christel ('871) in fig. 8 is still considered to fit the definition of "radial" i.e., "characterized by divergence from a center" as the array has a center and posts diverge from this center. The rejection of claims 14 - 21 under 35 USC 112 as failing to comply with the written description requirement is still deemed proper. Applicant's arguments based on exhibits 3 - 5, are not persuasive since the exhibits clearly disclose "electrokinetic" phenomenon to be a generic term that could indicate any one of or a combination of "electrophoresis", "electroosmosis", streaming potential" and "sedimentation potential". The instant specification's use of the generic term "electrokinetic" therefore does not provide support for the specific requirement of the "electroosmotic" species and certainly does not provide support for "avoiding suppression of electroosmotic flow". Further, electroosmotic flow will always be suppressed by friction and the instant specification does not explain how friction is avoided. Regarding applicant's arguments based on exhibit 6, which refer to the arguments presented during the prosecution of a previous application, applicant is reminded that previous patent prosecution is not precedent setting as it did not involve a precedential decision by the Board of Patent Appeals and Interferences (see Standard Operating Procedure 2 of the BPAI) and will not be treated as precedential. Regarding the rejection of claim 19 under 35 USC 102(e) as being anticipated by Austin ('664), Austin clearly discloses "employing electrokinetic transport" in column 10, line 44 - 45, "Alternatively, input fluid means 30 is a device that forces fluid through inlet 22 using electric fields". With regards to rejection of claims 14-20 under 35 USC 102(e) as being anticipated by Austin et al. ('664), applicant argues that Austin ('664) does not disclose employing electroosmotic flow or avoiding the suppression of electroosmotic flow, however, applicant is referred to figs. 1E and 1F wherein a coverglass 20 is used which would produce a stationary charged surface when "input fluid means 30 is a device that forces fluid through inlet 22 using electric fields" (column 10, lines 44 - 45) and hence employ electroosmotic flow. Additionally, Austin ('664) discloses in column 14, lines 43 - 45 that the solution is pumped or "otherwise transported" which does not preclude electroosmotic flow or avoid its suppression. Further, in example 3 disclosed in column 21, lines 48 - 50, Austin ('665) describes "the reaction products are launched directly into an array as described above" wherein "directly" does not convey adding electroosmosis suppression agent. In conclusion, it is believed that Austin ('664) discloses all the limitations of claims 14 - 20.


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